ESTTA Tracking number: ESTTA42879
Filing date: 08/22/2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91165809	
Party	Defendant Nalge Nunc International Corporation Nalge Nunc International Corporation 75 Panorama Creek Drive Rochester, NY 146020365	
Correspondence Address	DONALD F. FREI WOOD, HERRON & EVANS, L.L.P. 2700 CAREW TOWER 441 VINE STREET CINCINNATI, OII 45202-2917	
Submission	Answer	
Filer's Name	Sarah Otte Graber	
Filer's e-mail	sgraber@whepatent.com, dfrei@whepatent.com, usptodock@whepatent.com, afreeman@whepatent.com, driemann@apogent.com	
Signature	/Sarah O. Graber/	
Date	08/22/2005	
Attachments	Answer to Notice of Opposition.pdf (11 pages)	

I hereby certify that this correspondence is being transmitted electronically to the United States Patent and Trademark Office, Trademark Trial and Appeal Board, on the date shown below:

Sarah Otte Graber

Date

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN THE MATTER OF: Application No.: Mark: Int'l Class: Filing Date: Publication Date:	76572253 plastic water bottle (dec 021 January 26, 2004 March 24, 2005	2004	
TriForest Enterprises, Inc.,)		
Oppos	er,)		
V.)	Opposition No. 91165809	
Nalge Nunc International C	orporation,)		
Applic	ant.)		

Commissioner for Trademarks Trademark Trial and Appeal Board P.O. Box 1451 Alexandria, VA 22313-1451

ANSWER TO NOTICE OF OPPOSITION

The Notice of Opposition does not contain numbered paragraphs. For purposes of clarity, Applicant has attached to this Answer a copy of the Notice of Opposition with the

paragraphs thereof consecutively numbered. Applicant's answers set forth hereinafter are with reference to said consecutively numbered paragraphs shown on the attached copy of the Notice of Opposition.

- 1. No answer required.
- 2. Denied, except Applicant admits its mark has ornamental features.
- 3. Applicant lacks understanding and knowledge sufficient to form a belief as to the truth of these allegations and, therefore, denies the same.
 - 4. Denied.
 - 5. Admitted.
 - 6. Denied.
 - 7. Denied.
- 8. Applicant lacks knowledge and understanding of the meaning of "elements of the claim" or "public domain features" sufficient to form a belief as to the truth of the allegation and, therefore, denies the same.
- 9. With regards to the allegation in the first sentence of this paragraph,
 Applicant lacks sufficient knowledge and understanding of the meaning of "first element of the claim" or "Boston Round" and, therefore, denies same. With regards to the allegation in the third sentence of the this paragraph, to the best of Applicant's knowledge and belief, Owens-Illinois and Brockaway Glass have not, to date, manufactured a plastic water bottle having a tethered cap, and, therefore, Applicant denies the allegation. Applicant lacks knowledge and understanding sufficient to form a belief as to the truth of the remaining allegations of this paragraph and, therefore, denies same.

- 10. Applicant admits that the referenced website in this paragraph refers to "Boston rounds (narrow necks)," but denies that this term is used in close proximity to any particular glass bottle pictured therein. Applicant admits that the website link listed in this paragraph refers only to glass bottles used in the healthcare industry.
- 11. Applicant admits that the websites disclosed in this paragraph mention the phrase "Boston Round" in connection with bottles. Applicant denies that the bottles have the same shape as the design mark shown in Applicant's U.S. trademark application, Serial No. 76/572,253. Applicant admits the drawing included in this paragraph appeared in one of the referenced websites.
- 12. Applicant does not understand the meaning of the allegation in this paragraph: "The applicant also sells this type of bottle and would be injured if the application were registered," and therefore, denies same.
- 13. With regards to the allegation in the first sentence of this paragraph,
 Applicant lacks knowledge and understanding of the meaning of "second element of the
 claim" sufficient to form a belief as to the truth of the allegation and, therefore, denies
 same. Applicant denies the allegations in the second sentence of this paragraph.
- 14. Regarding the first sentence of this paragraph, Applicant lacks sufficient knowledge and understanding of the meaning of "third element of the claim" to form a belief as to the truth of the allegation and, therefore, denies same. Applicant lacks information with respect to the allegations of the second sentence of this paragraph and, therefore, denies same. Applicant admits the allegations in the third and fourth sentences of this paragraph. Applicant denies the allegations of the fifth sentence of this paragraph. Applies denies the allegations of the sixth sentence of this paragraph. With regard to the

seventh sentence of this paragraph, Applicant lacks knowledge and understanding sufficient to form a belief as to the truth of the allegations and, therefore, denies same.

- 15. Applicant admits a tether connecting a bottle and a cap reduces the likelihood a cap will become disconnected. With regards to the remaining allegations of this paragraph, Applicant lacks knowledge and understanding sufficient to form a belief as to the truth of the allegations and, therefore, denies same.
- 16. With respect to the first sentence of this paragraph, Applicant lacks knowledge and understanding of the meaning of "are established by standard sizes in the marketplace" sufficient to form a belief as to the truth of the allegation and, therefore, denies same. Applicant denies the remaining allegation in this paragraph.
- 16. Applicant denies the allegations in the eighteenth paragraph of Opposer's Notice of Opposition.
 - 17. Denied.

AFFIRMATIVE DEFENSES

A. FIRST AFFIRMATIVE DEFENSE

Applicant's design mark shown in U.S. Application Serial No. 76/572,253, is not functional, but is a distinctive mark capable of registration.

B. <u>SECOND AFFIRMATIVE DEFENSE</u>

To the extent the Applicant's mark is found functional, it is *de facto* functional, not *de jure* functional, and has acquired secondary meaning under Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f). *Valu Engineering v. Rexnord*, 278 F.3d 1268 (Fed. Cir. 2002).

C. THIRD AFFIRMATIVE DEFENSE

Opposer has failed to state a basis upon which the relief sought can be granted.

D. FOURTH AFFIRMATIVE DEFENSE

Opposer will not be damaged or injured if registration is granted to Applicant's mark, subject of the opposed trademark application.

WHEREFORE, Applicant prays that the opposition be denied and that the registration be granted.

Nalge Nunc International Corporation

Dated: August 22, 2005

Donald F. Frei (Sarah Otte Graber

WOOD, HERRON & EVANS, L.L.P. 441 Vine Street, 2700 Carew Tower Cincinnati, Ohio 45202 (513) 241-2324

Attorneys for Applicant

K:\NAC\125OP\Pleadings\Answer to Notice of Opposition.DOC

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **ANSWER TO NOTICE OF OPPOSITION** has been served upon Clement Cheng, Laws Offices of Clement Cheng,

17220 Newhope St., Suite 127, Fountain Valley, California 92703, Attorney for Opposer,

by First Class Mail this 22nd day of August, 2005.

Donald F. Frei

Sarah Otte Graber

WOOD, HERRON & EVANS, L.L.P.

441 Vine Street, 2700 Carew Tower

Cincinnati, Ohio 45202

(513) 241-2324

Attorneys for Applicant

THO

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark application Serial No. 76/572,253 For the Boston Round Bottle mark Published in the Official Gazette on (Date) 3/18/2005

TRIFOREST ENTERPRISES INCORPORATED v.
NALGE NUNC INTERNATIONAL CORPORATION

NOTICE OF OPPOSITION

BOX TTAB FEE
Mail Stop TTAB FEE
Assistant Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Commissioner:

Opposer:

TriForest Enterprises, Inc. 17 Musick Irvine, CA 92618

Applicant:

Nalge Nunc International Corporation a Deleware Corp. 75 Panorama Creek Drive Rochester NEW YORK 14602-0365

The above-identified opposer entity believes that it/he/she will be damaged by registration of the mark shown in the above-identified application of Nalge Nunc International Corporation (hereafter 'Nalgene'), and hereby opposes the same. The grounds for opposition are as follows:

This notice of opposition is meant only to plead ultimate facts rather than present a detailed analysis of the opposition itself. However, the following arguments are helpful in understanding the focus of the opposition.

The 76572253 mark is functional and does not have secondary meaning. In fact, when one looks at the bottle it is simply a Boston Round, which has been in the marketplace for many years. The particular shape and ornamental features of the bottle is more properly addressed by a design patent that has a monopoly lifetime of only 14 years rather than a trademark which would grant an unlimited monopoly. Prior registration number 2755757 also suffers the same defects, but is not at issue in this notice of opposition.

07/07/2005 KGIBBONS 00000016 76572253

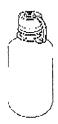
01 FC:6402

300.00 OP

Z:\Client 2. @ TM#TTAB#\Nalgene 76572253\Notice of Opposition.doc

07-05-2005

U.S. Patent & TMOfc/TM Mail Rept Dt. #39



- If the 76572253 mark is allowed to be registered, the applicant Nalgene would have a monopoly on the traditional Boston Round. This would hurt everyone in the industry, including the opposer, but would benefit the applicant Nalgene.
- The general shape of the bottle is very generic.
 - The application describes the mark as:

 The mark consists of a plastic water bottle as shown, namely, a plastic water bottle having a transparent, generally cylindrical container body with rounded shoulders interconnecting the upper and lower extremities of a cylindrical sidewall to a relatively narrow container neck and a generally flat, circular container bottom, respectively; an opaque screw cap releasably engaged with threads on the upper portion of the neck and having a button connected to the center of its top surface via a short stem; and a strap terminating in small and large annular rings respectively encircling the button stem and the lower portion of the neck such that the large annular ring is spaced apart and visually distinct from the screw cap, wherein the ratio of the diameter of the generally cylindrical container body to the overall height of the water bottle is approximately 0.4 and the ratio of the height of the generally cylindrical container body extending between the neck and
- This description of the mark sounds more like a utility patent claim than a trademark description. To illustrate, one can easily edit the mark description so that it reads like a patent claim. The edited patent claim is as follows:

the container bottom to the overall height of the water bottle is approximately 0.8.

I Claim: The mark consists of

a plastic water bottle as shown, namely, a plastic water bottle having comprising: a transparent, generally cylindrical container body with rounded shoulders interconnecting the upper and lower extremities of a cylindrical sidewall to a relatively narrow container neck and a generally flat, circular container bottom, respectively;

an opaque screw cap releasably engaged with threads on the upper portion of the neck and having a button connected to the center of its top surface via a short stem;

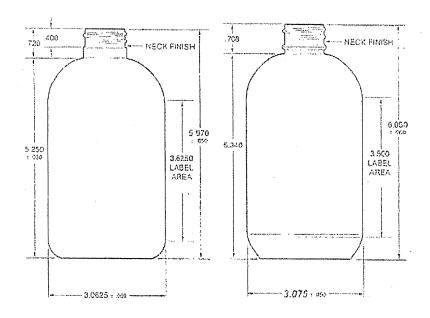
and a strap terminating in small and large annular rings respectively encircling the button stem and the lower portion of the neck such that the large annular ring is spaced apart and visually distinct from the screw cap, wherein the ratio of the diameter of the generally cylindrical container body to the overall height of the water bottle is approximately 0.4 and the ratio of the height of the generally cylindrical container body extending between the neck and the container bottom to the overall height of the water bottle is approximately 0.8.

- Allowing the applicant a trademark right over this particular claim, would effectively allow a utility patent of unlimited duration for the bottle configuration claim as rewritten above. That is entirely unfair and would damage the opposing party as well as many in the industry.
- 8 Particularly, we should look at the elements of the claim to find public domain features.
- The first element of the claim relates to the shape, generally known as the "Boston Round". This bottle has been around since early 1960's. There are many companies such as Owens-Illinois, and Brockaway Glass who have been manufacturing such bottles. If one takes a look on the Internet, the first mention of the design is as early as 1982.
- The Owens-Illinois website,

 http://www.o-i.com/pkgsolutions/healthcaremed/healthcare/glasspkgoverview.asp shows the Boston round.
- Additionally, the following links have the illustration of the Boston Round bottles.

 www.bomatic.com/Catalog/boston_pvc_18oz.html

 www.mayfairplastics.com/drawings/Boston16a1.gif



Material: HDPE Neck Finish: 28/410 Weight: 30 grams Bulk Pack: 175 Box w/Liner Box Size: 23 x 15 7/16 x 29 7/8 in. Box Weight: 15 (bs. S.P.I. Total mores Apply Unless Chinesess Noted

- The applicant also sells this type of bottle and would be injured if the application were registered.
- The second element of the claim is an opaque screw cap with a button, which is also highly common. The button is necessary to connect the tether in swivel configuration to the cap.
- The third element of the claim is the strap terminating in small and large annular rings. Opposer has filed a utility patent application for the connector "tether" and opposer's bottle is also sold to the same customers. The idea of connecting a string to a cap is not a new one. Many water bottles, canteens, and children's drinking vessels have connecting chains, strings and tethers on them to prevent loss of the caps. Nalgene is trying to register an obvious idea that has been around for some time. The connection of a tether to a Boston round bottle is necessary. The round profile contributes substantially to the strength of the bottle.
- The connecting tether prevents a user from inadvertently losing the cap. The lower annular ring is configured to retain the tether against the cap and the upper annular ring is configured to allow a shrinkwrap machine to shrinkwrap the top of the cap to the bottle.
- The overall height of the water bottle and the ratio of the height of the container body extending between the neck and the container bottom to the overall height of the water bottle are established by standard sizes in the marketplace. The ratios are commercially necessary so that

the bottles will fit into standard laboratory machines, packaging machines, and related bottle holders.

The highly functional nature of the claimed trademark suggests that the bottle does not have secondary meaning. There's nothing distinctive about any of the features listed. The features are very common and highly desirable functional characteristics that improve the strength, and ease of use of the bottle.

Therefore, the opposition prays that the applicant be denied registration.

By my signature below I declare under the penalty of perjury that the above statements and documents submitted are true and accurate to the best of my knowledge.

Date: Jun 29, 2005

Signature of Steve Lin, President

TriForest Enterprises, Inc.

17 Musick

Irvine, CA 92618 Fax 949.380.9955

This notice is being submitted in triplicate (original plus two copies) as required by 37 CFR 2.102(d). This notice includes check #5437 for \$300 pursuant to fee code 6402/7402 and CFR 2.6(a)(17); and return card.

Respectfully submitted,

By Clement Cheng:

withus Date: 6/30/2005 Law Offices of Clement Cheng 17220 Newhope St., Suite 127

Fountain Valley, CA 92708

Phone: 714-825-0555

Attorney for Opposer

I certify that today <u>+/1/05</u> (date), which is the date I am signing this certificate. this correspondence and all listed attachments are being deposited with the United States Postal Service and is addressed to:

Mail Stop TTAB FEE

Assistant Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-145